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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,001	08/01/2003	Walter Harvey Waddell	2003B079	8961

23455            7590            01/15/2008  
EXXONMOBIL CHEMICAL COMPANY  
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EXAMINER
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RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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01/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/633,001	WADDELL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vickey Ronesi	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 November 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4,6-14,16-24,27-31,33-35,38-43,47-49,51 and 53-88 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4,6-14,16-24,27-31,33-35,38-43,47-49,51 and 53-88 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 11/6/2007.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 11/6/2007. In particular, claim 88 is new. Thus, the following action is properly made final.

#### ***Claim Rejections - 35 USC § 112***

4. Claim 88 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 88 contains the trademark/trade names N762, N774, N907, N990, Regal 85, and Regal 90. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

trademark/trade name is used to identify/describe various carbon blacks and, accordingly, the identification/description is indefinite.

Furthermore, claim 88 is indefinite because it appears to improperly recite a Markush group. Consequently, it is impossible to determine which elements of the group are required by the claim. When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if “wherein R is a material selected from the group consisting of A, B, C and D” is a proper limitation, then “wherein R is A, B, C or D” shall also be considered proper (emphasis added). See MPEP § 2173.05(h).

***Claim Rejections - 35 USC § 103***

5. Claims 1, 3, 4, 6-14, 16-25, 27-31, 33-35, 38-43, 47-49, 51, 53-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al (WO 02/48257 A2, cited on IDS dated 12/15/2003).

With respect to claims 1, 3, 4, 6-14, 16-25, 27-31, 33-35, 38-43, 47-49, 51, 53-87, the rejection is adequately set forth in paragraph 4 of Office mailed 8/28/2007 and is incorporated here by reference.

With respect to new claim 88, Dias et al discloses the use of N762, N990, and Regal 85 (page 21, lines 18-20).

***Response to Arguments***

6. Applicant's arguments filed 11/6/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Dias fails to teach or disclose a carbon black with a specific combination of DBP and surface area values; (B) that presently claimed DBP of less than 70 is less than that of the carbon black exemplified by Dias; (C) that Dias does not teach or disclose a carbon black in an amount greater than 120 phr; (D) that an elastomer comprising at least 70 mol % of isobutylene is reasonably commensurate in scope with the elastomer in applicant's examples; (E) that Dias does not teach or disclose the use of more than one carbon black; and (F) that there is a trend in the exemplified data that supports unobviousness.

With respect to argument (A), Dias discloses the use carbon black which are useful in innerliners and innertubes such as N762, N990, and Regal 85 which inherently has a surface area of less than 30 m<sup>2</sup>/g and a dibutylphthalate oil absorption of less than 80 cm<sup>3</sup>/100 g (as disclosed by present disclosure on page 25, Table 2) or carbon black such as N660 which inherently has a surface area greater than 30 m<sup>2</sup>/g and a dibutylphthalate oil absorption of greater than 80 cm<sup>3</sup>/100 g (as disclosed by present disclosure on page 25, Table 2).

With respect to argument (B), case law holds that "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

With respect to argument (C), Dias teaches 10-150 phr of carbon black (page 21, lines 12-13) which overlaps with the presently claimed range of 80-200 phr.

With respect to argument (D), only bromobutyl elastomers are exemplified and cannot establish criticality for presently claimed generic elastomer comprising at least 70 mol % isobutylene. In particular, the presently claimed elastomer does not even necessarily include a halogen.

With respect to argument (E), case law holds that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d 506,509, 173 USPQ 356, 359 (CCPA 1972). Therefore, given that Dias teaches the use of both types of carbon black, it would have been obvious to one of ordinary skill in the art to utilize a combination of the two, absent evidence of unexpected or surprising results.

With respect to argument (F), the trend in the data is not reasonably commensurate in scope with the scope of the claims. Specifically the trend cannot support criticality for a single carbon black having the presently claimed structure.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/8/2008  
Vickey Ronesi

*VR*

/Vasu Jagannathan/  
Supervisory Patent Examiner  
Technology Center 1700